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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/887,781	06/22/2001	Carol Ann	END920000180US1	8707
7590 Karuna Ojanen 2665 Riverside Ln NE Rochester, MN 55906			EXAMINER NGUYEN, TAN D	
			ART UNIT 3629	PAPER NUMBER
			MAIL DATE 11/19/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/887,781	ANN ET AL.	
	Examiner	Art Unit	
	Tan Dean D. Nguyen	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,6,9,10 and 13-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,6,9,10 and 13-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed 9/12/06 has been entered. Claims 1-2, 4, 6, 9-10, 13-30 are pending and rejected below. The claims consist of 3 independent claims which comprises 2 system claims: 1-2, 4-6, 18-29, and 30, and a method claim: 9-10, 13-17. Claim 1 is broadest and will be examined first.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 1-2, 4-6, 18-29, and 30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, not a method (process), machine (apparatus), manufacture (article, product), or composition of matter.**

As of 9/12/06, claim 1 is as below:

1. (Previously presented) An enterprise system for modeling the operation of a business enterprise and its information processing, the system comprising:
 - (a) a first architectural portion integrated in a database, the first architectural portion comprising business operations and objectives of the business enterprise;
 - (b) a second architectural portion integrated in the database, the second architectural portion comprising an information technology processing system which the business uses to conduct its business; and

c) whereby changes to one of the architectural portions are assessed for impact on the other of the architectural portions prior to implementation.

Note: for convenience, letters (a)-(b) are added to the beginning of each step.

As shown above, the system of claims 1-2, 4-6, 18-29, and 30 are merely structures in a database and the major element/step of the claimed invention (c) is not a structure or element but merely a negatively stated step (... changes are assessed ...) which have no patentable weight in an apparatus claim.

Moreover, they are merely modeling instruments comprising a disembodied abstract ideas and do not produce any tangible, concrete and repeatable results.

Claims 9-10, 13-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims deal with a model for considering the effects of changes in the organization and comprising disembodied abstract ideas and do not produce any tangible, concrete and repeatable results. Note also the last step is written in a negative stated step (...changes are assessed ...) which does not have a lot of patentable weight in a method claim. At the most, it's interpreted as "being capable of" and this does not produce tangible, concrete and repeated results. Changing the language to a positive step of "assessing the changes" is recommended to improve clarity and receive patentable weight in a method claim.

Claim Rejections - 35 USC § 112

3. Claims 1-2, 4, 6, 18-29, 9-10, 13-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(1) Claim 1 is vague. The use of pronoun such as "its" is vague and should be canceled and replaced with the exact term it's replacing.

(2) Claim 2 is vague, it's not clear how the "objectives" are carried out and reflected in the enterprise system.

(3) In claim 9, the last 4 lines are vague and appear to be redundant of the same issue.

(4) Claims 13-17 recites the limitation "the operation of an organization" in line 1. There is insufficient antecedent basis for this limitation in the claim.

(5) In dependent claims 15-17, the phrase "the architectures are prepared" is vague and indefinite because claim 9, line 2, calls for "... to provide a single structure for considering the effects of changes", and it's not clear the architectures refer to the single structure or all of the structures include the single structure.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. **Claims 1-2, 4, 6, 18-29 (system 1), 30 (system 2), 9-10, 13-17 (method) are rejected under 35 U.S.C. 103(a) as being unpatentable over CORNELIUS ET AL.**

As of 9/12/06, claim 1 is as below:

1. (Previously presented) An enterprise system for modeling the operation of a business enterprise and its information processing, the system comprising:
 - (a) a first architectural portion integrated in a database, the first architectural portion comprising business operations and objectives of the business enterprise;

(b) a second architectural portion integrated in the database, the second architectural portion comprising an information technology processing system which the business uses to conduct its business; and

c) whereby changes to one of the architectural portions are assessed for impact on the other of the architectural portions prior to implementation.

Note: for convenience, letters (a)-(b) are added to the beginning of each step.

Similarly, CORNELIUS ET AL discloses an enterprise system for modeling the operation of a business enterprise and its information processing, the system comprising:

(a) a first architectural portion integrated in a database, the first architectural portion comprising business operations and objectives of the business enterprise;

{see col. 41, lines 61-67, col. 42, lines 1-27, col. 51, lines 3-60, Fig. 81, Fig. 97}

(b) a second architectural portion integrated in the database, the second architectural portion comprising an information technology processing system which the business uses to conduct its business; and

{see col. 42, lines 5-10, col. 44, lines 45-62, Fig. 81, 8102, Fig. 97}

c) whereby changes to one of the architectural portions are assessed for impact on the other of the architectural portions prior to implementation.

{see col. 54, lines 24-42, col. 59-60, col. 61, lines 12-35, col. 68, lines 5-20, cols. 86-88, which deal with "implementation" issues, cols. 96-97, Fig. 81, 8120}

CORNELIUS ET AL fairly teaches the claimed invention except for explicitly disclosing the use a database for storing structures (a) and (b). Note that it appears

that the Framework which includes managing change shown in Fig. 81 is carried out on a single database, Fig. 81, 8102. CORNELIUS ET AL also discloses the use of more than one database, see Fig. 97. Alternatively, the selection of the number of databases varies cost, space, degree of complexity or uniformity, speed, etc. and it would have been obvious to a skilled artisan to use the same database for storing structures (a) and (b) above to reduce cost and/or improving uniformity. Note, also on col. 42, lines 5-25, CORNELIUS ET AL discloses the use of various business operations, such as (a) Information Management processing system, in the Process Model. The use of other well known business processes or processing system such as Information Technology processing system in the Process Model above would have been obvious as mere selection of other well known business process or structures of the business enterprise. Moreover, the term "information technology" is non-functional in a data processing system especially in an apparatus claim.

As for dep. claim 2 (part of 1 above) which deal with an element/item for carrying out the objective of the business, this is taught in Fig. 81, 8136, 8112.

As for dep. claim 4 (part of 1 above) which deal with an element/item for changing/modifying business element, this is taught in Fig. 81, 8120 or cols. 54-60.

As for dep. claims 6, 18-29 (part of 1 above) which deal with architecture (organization structures) parameters for the business enterprise and the information technology, these are fairly taught in cols. 41-42, 44-53, Figs. 81, 83-85, etc. Moreover, these terms or structures appear to be non-functional in a data processing system especially in an apparatus claim.

As for independent system claim 30, which appears to be the combination of claims 1, 2, 4, 6 and 18-29, it's rejected for the same reasons set forth in the rejections of claims 1 and its dependent claims above. Note that elements (a)-(p) are merely business structures and only the last phrase reflects the scope of the invention which is assessing impact due to changes.

As for independent method claim 9, which appears to be the steps to carry out the system claim 1 above, it's rejected for the same reasons set forth in the rejections of claim 1. Note also the last step is written in a negative stated step (...changes are assessed ...) which does not have a lot of patentable weight in a method claim. At the most, it's interpreted as "being capable of" and the method of of CORNELIUS ET AL is capable of that. Changing the language to a positive step of "assessing the changes" is recommended to improve clarity and receive patentable weight in a method claim.

As for dep. claims 10, 13-14 (part of 9 above) which have the same limitation as in dep. claims 4, 6, 19 (part of 1 above), they are rejected for the same reasons set forth in the rejections of dep. claims 4, 6 and 19 above. Moreover, these terms or structures appear to be non-functional in a data processing system especially in an apparatus claim.

As for dep. claims 15-17 (part of 9 above), which deal with the architecture changing parameters, i.e. customizing it to a particular instance, etc., these are fairly taught in cols. 54, 68, etc. Note also the last step is written in a negative stated step (...changes are assessed ...) which does not have a lot of patentable weight in a method claim. At the most, it's interpreted as "being capable of" and the method of of

CORNELIUS ET AL is capable of that. Changing the language to a positive step of "assessing the changes" is recommended to improve clarity and receive patentable weight in a method claim. Moreover, these terms or structures appear to be non-functional in a data processing system especially in an apparatus claim.

No claims are allowed.

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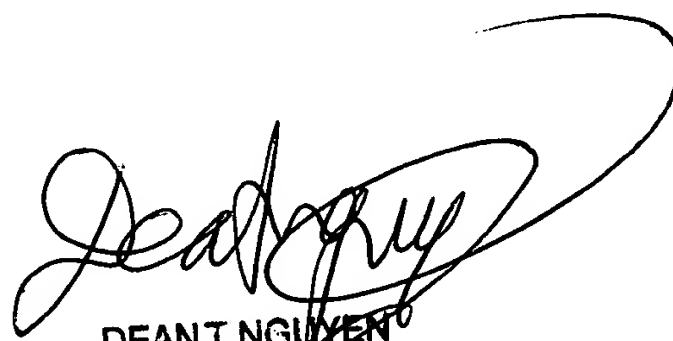
In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov.

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss can be reached at (571) 272-6812.

The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn
November 13, 2007



DEAN T. NGUYEN
PRIMARY EXAMINER